

REMARKS***Status of the Claims***

Claims 6, 12, 51, 65, 72, 81, and 82 are hereby canceled.

Claims 1, 3, 7, 8, 11, 16, 17, 38, 52-61, 66-69, 71, 73, 74, 83, 86-89, 93, and 94 are hereby amended.

Claims 101-114 are new.

Thus, claims 1, 3-5, 7-11, 13-34, 38, 41-50, 52-64, 66-69, 71, 73-80, 83-94, and 101-114

are currently pending in this application.

The Applicants hereby request further examination and reconsideration of the presently claimed application.

Allowable Subject Matter

The Applicants thank the Examiner for acknowledging that claims 12, 65-69, and 82 would be allowable if rewritten in independent form. The limitations of claim 65 have been incorporated into claim 38, and the limitations of claim 82 have been incorporated into claim 71. Thus, claims 38, 41-50, 52-64, 66-69, 71, 73-80, and 83-85 are now in condition for allowance.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3-6, 11, 18-20, 22, 32-34, 38, 41, 42, and 45-50 stand rejected under 35 U.S.C. § 102(e) as anticipated by *Cooke* (U.S. Patent Application Publication 2004/0231845). As described above, and the limitations of allowable claim 65 have been incorporated into claim 38. Thus, claims 38, 41, 42, and 45-50 are in condition for allowance. In addition, claim 6 has been canceled, and claims 3-5, 11, 18-20, 22, and 32-34 depend on independent claim 1. Thus, claims 1, 3-5, 11, 18-20, 22, and 32-34 stand or fall on the application of *Cooke* to independent claim 1. According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth

in the claim is found, either expressly or inherently described, in a single prior art reference.” The Applicants submit that claims 1, 3-5, 11, 18-20, 22, and 32-34 are not anticipated by *Cooke* because *Cooke* fails to teach each and every element in independent claim 1.

Amended claim 1 recites the limitation “wherein the biodegradable material comprises one or more compounds selected from the group consisting of polysaccharides, chitin, chitosans, poly(ethylene oxides), poly(phenyllactide), and polyphosphazenes.” *Cooke* fails to teach that the biodegradable material may comprise one or more compounds selected from the group consisting of polysaccharides, chitin, chitosans, poly(ethylene oxides), poly(phenyllactide), and polyphosphazenes. Thus, *Cooke* fails to anticipate claim 1, and claims 1, 3-5, 11, 18-20, 22, and 32-34 should be allowed over *Cooke*.

Claim Rejections - 35 U.S.C. § 103

Claims 7-10, 13-17, 23-31, 43, 51-64, 71-81, and 83-94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooke* in view of *Bigg* (U.S. Patent 6,323,307). Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooke* in view of *Erbatoesser* (U.S. Patent 4,716,964). Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooke* in view of *Bigg* and *Erbatoesser*. Claims 7-10, 13-17, 21, and 23-31 depend on claim 1, which is allowable for the reasons given above. Thus, claims 7-10, 13-17, 21, and 23-31 are in condition for allowance. Claim 51 has been canceled, and claims 43, 44, and 52-64 depend on claim 38, which is allowable for the reasons given above. Thus, claims 43, 44, and 52-64 are in condition for allowance. Claims 72 and 81 have been canceled, and the limitations of allowable claim 82 have been incorporated into claim 71. Thus, claims 71, 73-80, and 83-85 are in condition for allowance. Claims 87-94 depend on independent claim 86, thus claims 86-94 stand or fall on the application of *Cooke* and *Bigg* to independent claim 86. MPEP

§ 2142 requires that “the prior art reference must teach or suggest all the claim limitations” in order to establish a *prima facie* case of obviousness. The Applicants submit that *Cooke* and *Bigg* fail to present a *prima facie* case of obviousness with regards to claims 86-94 because *Cooke* and *Bigg* fail to teach or suggest the claimed limitations.

Amended claim 86 recites the limitation “lowering an enclosure comprising the chemical solution into the well bore, wherein the enclosure is separate from the disposable downhole tool or the component thereof; and releasing the chemical solution.” *Cooke* and *Bigg* fail to teach or suggest “lowering an enclosure comprising the chemical solution into the well bore, wherein the enclosure is separate from the disposable downhole tool or the component thereof; and releasing the chemical solution.” Thus, *Cooke* and *Bigg* fail to present a *prima facie* case of obviousness with respect to claim 86, and claims 86-94 should be allowed over *Cooke* and *Bigg*.

New Claims

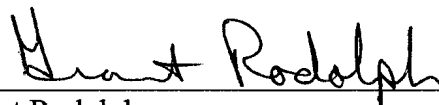
New claims 101-114 recite novel and non-obvious aspects of the invention not disclosed by *Cooke*, *Bigg*, or *Erbatoesser*. Support for these limitations is found in paragraphs 22-37 and 49 of the specification. New claims 101-114 depend from allowable claims 1, 38, 71, and 86, and thus claims 101-114 are allowable over *Cooke*, *Bigg*, and *Erbatoesser*.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by the Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated May 31, 2007 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.



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